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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/360,521	07/23/99	RESTLE S	05725.0446-0

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EXAMINER	
WELLS,L	

ART UNIT	PAPER NUMBER
1619	11

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary	Application No.	Applicant(s)	
	09/360,521	RESTLE ET AL.	
	Examiner	Art Unit	
	Lauren Q Wells	1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 March 2001* .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *1* .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The use of the trademarks has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

The attempt to incorporate subject matter into this application by reference to Patent Application EP-A-95,238 is improper because it is a foreign application.

Double Patenting

Claims 1-46 directed to an invention not patentably distinct from the claim of commonly assigned Patent Numbers 6,028,041 and 6,159,914. Specifically, all claims are directed toward

analogous hair compositions comprising aminated silicones, amphoteric surfactants, anionic surfactants, and washing bases.

Commonly assigned 6,028,041 and 6,159,914 discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-46 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,028,041, 6,159,914, 6,,022,836, 5,650,383. Although the conflicting claims are not identical, they are not patentably distinct from each other because all sets of claims are drawn towards analogous hair compositions comprising aminated silicones, anionic surfactants, amphoteric surfactants, and washing bases.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 20, 24-26, 32, 34, 35, 29-42 and 44-46 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claims 1, 20, 22, 24-26, 32, 34, 35, 39-42, 44-46 are rejected for the use of improper Markush groups. See MPEP 2173.05(h) for examples of proper conventional or alternative Markush-type language (i.e. ". . .chosen from the group consisting of. . .and . . .".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (f) he did not himself invent the subject matter sought to be patented.

Claims 1-46 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The claims of Decoster et al. 6028,041 and Decoster et al. 6,159,914 are directed toward analogous hair compositions comprising aminated silicones, anionic surfactants, amphoteric surfactants, and a washing base.

Claims 1-12, 22-25, 32, 39, and 43-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Morlino (4,185,087).

Morlino teaches hair conditioning compositions containing dialkylamino hydroxy organosilicon compounds and their derivatives. Disclosed is a method of condition hair which comprising applying to the hair an effective amount of a composition containing 0.1-10%of formula (IV) of the instant invention, 75-99.9% water, 0-30% of one or more amphoteric, cationic, anionic, non-ionic, polar non-ionic or zwitterionic surfactants, which meets claims 1-5, 22-25, 32, 39, 43-46. The anionic surfactant is disclosed as comprising up to 8% of the composition, while the amphoteric surfactant is disclosed as comprising 9-30% of the composition, see Col. 3, lines 45-54 and Col. 6, lines 41-50, which meets claims 6-12. See Col. 1, line 6-Col. 9, line 16; Col. 11, line 48-Col. 14, line 15.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

> This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the

time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morlino in view of Hughes (5,567,428), in further view of Naito et al. (5,476,649).

Morlino fails to teach aminated silicone polymers, 18-methyl-eicosanoic acid, cationic polymers, and cosmetically acceptable solvents (see above discussion).

Hughes teaches topical personal care compositions containing polysiloxane-grafted adhesive polymers. Disclosed is a hair styling/conditioning rise composition comprising trimethylsilylamodimethicone, ditallow dimethyl ammonium chloride (cationic polymer), tallow trimethyl ammonium chloride (cationic polymer), and amodimethicone, which meets claims 13-21, 26-31. Cationic polymers disclosed include diallyldimethylammonium salt homopolymers, copolymers of diallyldimethylammonium salt and acrylamide, cationic polysaccharides, and copolymers of vinylpyrrolidone and methylvinylimidazolium salt, which meets claims 34, 36-38. Carriers disclosed include C1-C12 alcohols, such as ethanol, which meets claims 40 and 42. Disclosed as polymer plasticizing agents are glycerin (glycerol) and propylene glycol comprising 0.01-10% of the composition, which meets claims 40-43. See Col. 2, lines 42-Col. 3, line 55; Col. 11, line 15-Col. 36, line 12; Col. 37, line 61-Col. 40, line 11.

Naito et al. teach hair cosmetic compositions comprising branched fatty acids. 18-methyleicosanoic acid is disclosed as the preferred branched fatty acid. See Col. 1, line 53-Col. 5, line 58; Col. 8, line 34-Col. 26, line 33.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Morlino by substituting the aminated silicone

polymer of Hughes for the cationic silicone polymer of Morlino and obtain a detergent and conditioning cosmetic composition because a) Hughes teaches the cationic silicone polymer as combinable and interchangeable with the aminated silicone polymer; b) Hughes teaches the aminated silicone for use in hair conditioners for the purpose of decreasing drying time and increasing style hold strength. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding the 18-methyleicosanoic acid of Naito et al. and obtain a hair care composition comprising a washing base, a conditioner system, and 18-methyleicosanoic acid because a) Naito et al. teach the addition of 18-methyleicosanoic acid in hair cosmetic compositions as giving hairs excellent moist, soft, smooth, and glossy conditioning effects which persist after repeated shampooings; b) Morlino teaches that the composition can contain other conditioning agents; c) Hughes teaches mono-carboxylic acid esters as conditioning agents.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

DAMERON L. JONES
PRIMARY EXAMINER

lqw
April 17, 2001